

Response dated 03/03/2006

Response to Office Action dated 01/04/2006

Application No. 09/737,098

**REMARKS**

Claims 1, 4-9, 12-15, 18-20, and 27-29 are pending. Claims 1, 4-9, 12-15, 18-20, and 27-29 are rejected.

**Claims Rejections****35 U.S.C. §103 Rejections**

Claims 1, 4-8, 15, 18-20, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,521,966 (Friedes), in view of US Patent No. 6,253,069 (Mankovitz) in view of US Patent No. 6,040,921 (Hayashi), and in further view of US Patent No. 6,728,348 (Denenberg).

The Office Action admits that (Page 4. Emphasis added.):

Friedes as modified discloses conversion from DTMF to a digit but fails to disclose the caller selects only one DTMF entry for each character in a name and an address of the person.

However, Denenberg teaches a system wherein the caller selects only one DTMF entry for each character in a name and an address of the person to form a digit string (column 5, lines 17-34); and

e) a data search handler that searches the searchable database by matching the digit that corresponds to an actual name and address of the person (column 5, lines 38-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to further modify Friedes using the teaching of a single DTMF entry as taught by Denenberg.

The modification of the invention would offer the capability of having the caller selects only one DTMF entry of each character in a name and an address of the person such as the user would have the advantage to spell the name to be searched.

Denenberg does not even suggest the feature of "a data search handler that searches the searchable database by matching the digit string that corresponds to an actual name and address of the person." (Emphasis added.) Denenberg merely discloses (Column 5, lines 38-39.):

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Next, the system determines 44 which names in dictionary 18 have the signature entered by the user.

Denenberg fails to even suggest matching an address of a person and merely discloses matching a user's name. Moreover, the Office Action alleges that there is motivation to combine Denenberg with Friedes. However, Denenberg (col. 5, line 17 – col.6, line 16) requires additional interaction (that may necessitate speech generation and speech recognition) with the user if the signature of the user's name is not unique. This additional interaction removes any motivation for combining Denenberg with Friedes. Consequently, the Office Action fails in establishing a *prima facie* case of obviousness.

Independent claim 15 includes the similar features of “a plurality of modems for converting a dual-tone multi-frequency (DTMF) signal into one digit, wherein the caller selects only one DTMF entry for each character in a name and an address of the person to form a digit string” and “a data search handler that searches the searchable database by matching the digit string that corresponds to an actual name and address of the person.” Independent claim 27 also includes the features of “plurality of modems for converting a dual-tone multi-frequency (DTMF) signal into one digit, wherein the caller selects only one DTMF entry for each character in a name and an address of the person to form a digit string” and “a data search handler that searches the searchable database by matching the digit string that corresponds to an actual name and address of the person.” Thus, claims 15 and 27 are patentable for at least the above reasons. Claims 4-8, 18-20, and 28-29 ultimately depend from claims 1, 15, and 27.

Furthermore, the Office Action has pointed to no motivation to combine the references in the references themselves or pointed to anything supporting the idea that the motivation was generally known to one of skill in the art. See MPEP 706.02(j) (“To establish a *prima facie* case of

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obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."'). Instead, the Office Action has provided what appears to be motivation that was generated using hindsight reconstruction. Applicant requests reconsideration of claims 1, 4-8, 15, 18-20, and 27-29.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedes, in view of Mankovitz, in view of Hayashi and further in view of Denenberg as applied to claim 1, and further in view of US. Patent No. 5,901, 214 (Shaffer).

Claims 6-8 ultimately depend from claim 1. Moreover, Shaffer does not make up for the deficiencies of Friedes, Mankovitz, Hayashi, and Denenberg and are thus patentable for at least above reasons.

Furthermore, the Office Action has pointed to no motivation to combine the references in the references themselves or pointed to anything supporting the idea that the motivation was generally known to one of skill in the art. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."'). Instead, the Office Action has provided what appears to be motivation that was generated using hindsight reconstruction. Therefore, for this additional reason the combination of Friedes, Mankovitz, Hayashi, Denenberg, and Shaffer fails to support a *prima facie* case of obviousness. Accordingly, Applicant requests reconsideration of claims 6-8.

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**Claims 9 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedes, in view of Mankovitz, in view of Hayashi, in view of Denenberg and in further view of US Patent No. 6,446,111 (Lowery).**

Independent claim 9 includes the features of "a plurality of modems for converting a dual-tone multi-frequency (DMTF) signal into one digit, wherein the caller selects only one DTMF entry for each character in a name and an address of the person to form a digit string" and "a data search handler that searches the searchable database by matching the digit string that corresponds to an actual name and address of the person." As discussed above, the combination of Friedes, Mankovitz, Hayashi, and Denenberg does not even suggest these features. Moreover, Lowry does not make up for the deficiencies of Friedes, Mankovitz, Hayashi, and Denenberg. Also, claims 12-14 depend from claim 9 and are patentable for at least the above reasons.

In addition, the Office Action suggests the motivation to add Lowry would to add the features of Lowry to Shaffer. However, Shaffer is not included in the five references used to reject claims 9 and 12-14, thus the motivation provided by the Office Action necessarily fails to support a *prima facie* case of obviousness. Moreover, there does not appear to be any motivation to combine Lowry with Friedes. Applicant requests reconsideration of claims 9 and 12-14.

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All objections and rejections have been addressed. Hence, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

Respectfully submitted,

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By:



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